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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/326,106 06/04/99 GEBEYEHU

G 45-93A

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HM22/0502

EXAMINER

MARSCHER, A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED:

05/02/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/326,106

Applicant(s)

Gebeyehu et al.

Examiner
Ardin Marschel

Group Art Unit
1631



☒ Responsive to communication(s) filed on Feb 14, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-64 is/are pending in the application.
- Of the above, claim(s) 1-10, 23-30, and 51-64 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 11-22 and 31-50 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-64 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☒ Information Disclosure Statement(s), PTO-1449, ~~(2 sheets)~~ (2 sheets)
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part of Paper No. 6

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Newly submitted claims 51-64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The compounds given in instant claim 51, directed to "Z" entities with tertiary amines additionally attached thereto as R_1 and/or R_2 moieties, are newly submitted compounds which were not presented in the claims that were considered for the action, mailed 8/27/99. Such tertiary amine containing R groups would require an undue additional search burden because polymerization which would link the Z groups would require separate and distinct protection chemistry due to the known high reactivity of tertiary amines that would cause incorrect polymerization unless prevented from reacting. This added protection chemistry would require a significant, additional, and burdensome search over the search for the compounds that have already been elected and thus supports this restriction by original presentation.

Since applicants have received an action for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 51-64 are withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b)

and MPEP § 821.03.

It is noted also that claims 36 and claims dependent directly or indirectly therefrom include both elected and non-elected compositions. The non-elected compositions are those wherein the A_1 and/or A_2 moieties are complex in that they contain linkers such as those given as the entities "B" or "D" described regarding moieties X_5 or X_6 within claim 36. Claims 36 etc. will be examined to the extent of their content of elected subject matter embodiments.

Applicants' election with traverse of Group II (claims 11-22; now claims 11-22 and 31-50) in Paper No. 5, filed 2/14/00, is acknowledged. The traversal is on the grounds that the compounds of Groups I and II are classified into the same subclass, share similar function, and common structural features. This relatedness is argued as the search for both Groups of claims does not represent an undue search burden. This is not found persuasive because the differing synthetic requirements of the two Groups would necessitate a separate search thus causing the search regarding both Groups together versus separately would virtually double the search burden. It is noted that the search burden for one group alone is significant and searching them together would require a separate chemical structure search for "A" linker containing compounds. It is noted that applicants have not argued the basis for the restriction as being directed

to differing structural requirements as noted in the previous action, mailed 8/27/99. Thus, the traversal arguments are not directed to the basis for the restriction and therefore is also non-persuasive for that reason.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-22 and 31-50 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11, for example, depicts the compounds therein described via a structural formula which contains monomers which are repeated "n" times. The claims do not define whether the repeat monomers are linked to each other or not. Also, the claims do not define whether linkages are formed between the R groups, the Z groups, or the R to Z groups of each monomer to make a repeat containing compound. Thus, the claims are vague and indefinite as to metes and bounds what is meant regarding the claimed compound. Clarification is requested via clearer claim wording. These unclarities are also in claims that are dependent from claim 11 due to their dependence.

In line 1 of claims 11 and 36 the open claim word "having" is given. This limitation is generally accepted in claim language but in the instant claims 11 and 36 it causes the claims

to be vague and indefinite because this open claim language term indicates that the claimed compounds also contain more than what is given in the structural formula but does not define several important details of such additional compound content. Does the additional material serve as substituents of the R or Z groups? What part of the R or Z groups would such added material be linked to? Is it linked at all to either the R or Z groups? Clarification is requested via clearer claim wording. These unclarities are also in claims that are dependent from either of claims 11 or 36 due to their dependence.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 15, 16, and 34 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by various polyamino acids of the 1990 Sigma Chemical Catalog.

In instant claim 11, one option is a compound of Z = an amino acid such as glycine with R being an alkyl group. Polyalanine, for example, given as product P 5512 or P 5517 on page 1649 of the 1990 Sigma Chemical Catalog anticipates such an embodiment of the instant claims. Other polyamino acids read on

the claims in the same way such as polyvaline, product P 3908 on page 1654, or polyleucine, product P 5762 through P 2020 on page 1651. See also products P 8035 and P 1388 on pages 1650 and 1653, respectively. Similar to the above issue the product P 6905 on page 868 of the Sigma Chemical Catalog is a methyl R group containing polymer of uridylic acid which in combination is polythymidylic acid which reads on the polymer of monosaccharides of Uridine with a methyl R group.

No claim is allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technical Center receptionist whose telephone number is (703) 308-0196.

April 28, 2000

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER